

MARKED-UP VERSION OF AMENDMENTS

Claims 11-13 have been canceled.

Claim 8 has been amended as follows:

8. (Three Times Amended) Process for making a paper comprising a pattern embossed on at least one side, said pattern being constituted by the combination of ~~at least one~~ a ground and at least one inlaid area, ~~at least one of the grounds~~ the ground and at least one of the inlaid areas having wefts with different slants and shapes, by means of a vat paper machine comprising a cylinder, a pick-up felt and a wet press having a top felt, said process comprising the following steps:

- a wet sheet of cellulose fibers comprising water is formed by means of said cylinder,

- the wet sheet is picked up by the pick-up felt and is carried between said wet press to remove the water, and

- the sheet of cellulose fibers is dried,

wherein the embossed pattern is formed on said sheet before it is dried by applying thereon a cloth that is placed directly on the cylinder, or in place of the pick-up felt, or in place of the top felt on the wet presses, said cloth being metallic or made of plastic material, and said cloth being woven and comprising a pattern, said pattern being constituted by a combination of ~~at least one~~ a ground and at least one inlaid area, the ground and the inlaid area having wefts with different slants and shapes.

New claims 18-26 have been added.

REMARKS

By the present amendment, claims 11-13 have been canceled, claim 8 has been amended, and new claims 18-26 have been added.

Claim 8 has been added to clarify that the pattern has a ground. New claim 18 corresponds to claim 17 rewritten in independent form. Claims 19-21 correspond to claims 11-13 but are directed to a vat paper machine comprising the woven cloth made of a metallic or plastic material. Claims 22 and 23 correspond to claims 16-17 but claim 22 depends on claim 19 and claim 23 incorporates the subject matter of claim 19 and is directed to a vat machine comprising a cylinder, a pick-up felt and a wet press. Claims 24-26 correspond to claims 19-21 except that they are directed to a paper machine.

Claims 8 and 16-26 are pending in the present application. Claims 8 and 16-18 are directed to a process for making a paper, claims 19-22 are directed to a vat paper machine, claim 23 is directed to a vat machine and claims 24-26 are directed to a paper machine.

In this Office Action, claims 8 and 11-13 are again rejected under 35 U.S.C. 103(a) as obvious over US 361,849 (Taylor) in view of US 2,890,540 (Britt). It was alleged in the previous Office Action that Taylor discloses using a fabric attached to a belt to create a fabric pattern and Britt discloses a “damask” fabric pattern, so that it would have been obvious to modify the process of Taylor to obtain a “damask” pattern as in Britt. Further, in paragraph 6 of this Office Action, it is alleged that the teaching in Taylor that a loosely woven fabric works best does not constitute a negative teaching as to other types of fabric but only describes a non-restrictive preferred embodiment.

Reconsideration and withdrawal of the rejection is respectfully requested.

With respect to claims 11-13, since these claims have been canceled, the rejection is moot.

With respect to claim 8, it is submitted that, first, nothing in Britt suggests that a cloth might constitute an alternative to the engraved roll of Britt for making damask patterns, and Taylor is completely silent as to whether its cloth might be suitable for making damask patterns, so that any motivation to combine is absent from these documents.

Second, even if, *arguendo*, Taylor describes a loosely woven fabric as a preferred but non-exclusive embodiment for making embossed patterns, as alleged in the Office Action, this falls short of providing, to a person of ordinary skill in the art, a motivation to use a cloth of metallic or plastic material to make damask patterns, for example, in the machine of Britt.

Specifically, still *arguendo*, if a person of ordinary skill in the art would not have been satisfied with the engraved cylinder of Britt for making damask patterns, and that person would have looked to Taylor for alternative teachings, as alleged in the Office Action, that person would not have found any specific teaching suggesting that the use of a metallic or plastic fabric might be advisable for damask patterns. Rather, the person of ordinary skill in the art would only have found in Taylor the general teaching that loose fabrics are the best choices for producing embossed patterns. As a result, the person of ordinary skill in the art would not have been led to select another type of fabric, for example, a metallic or plastic cloth.

In the alternative, the person of ordinary skill in the art, faced with the disclosure in Taylor of a broad range of fabrics for making embossed patterns, and realizing that the preferred cloth of Taylor is not suitable to make damask patterns, would have been left to experiment in order to

identify which fabrics, among the various types encompassed by Taylor, might be suitable for making damask patterns. Such endeavor would have been totally beyond the purview of a person of ordinary skill in the art.

In contrast, the present inventors have addressed the problem of making papers with damask patterns and determined that a cloth made of a metallic or plastic material provides satisfactory results because it can penetrate in wet paper to an extent sufficient to form points or dashes that are (i) appropriately individualized, but also (ii) disposed sufficiently close to each other to confer the damask aspect to the paper.

It is noted that Taylor and Britt date from 1877 and 1955, respectively, which weighs against the position set forth in the Office Action that a person of ordinary skill in the art would have combined Taylor and Britt and arrived at the presently claimed invention. Rather, the long delay (40+ years) between the publication of Britt and the present invention suggests that, even though damask patterns were desired, as evidenced by Britt, it was not an simple task to (i) identify the use of a cloth as an alternative to the roll of Britt for making paper with damask patterns, (in particular because Britt does not discuss cloth for making patterns, and Taylor does not discuss damask patterns), and (ii) select the use of a metallic or plastic material for the cloth (in particular because Taylor recommends a loosely woven fabric to make embossed patterns).

In view of the above, it is submitted that the rejection should be withdrawn.

Next, in the Office Action, claims 11-13 are rejected under 35 U.S.C. 102(b) over commercially available cloth.

Since claims 11-13 have been canceled, the rejection is moot.

Next, in the Office Action, claims 8 and 16 are rejected under 35 U.S.C. 103(a) as obvious over EP 458 973 (Hiyoshi) in view of Britt. It is alleged in the Office Action that Hiyoshi discloses using a patterned fabric on a cylinder of a paper-making machine, so that it would have been obvious to use a fabric having a damask pattern as in the roll of Britt.

Reconsideration and withdrawal of the rejection is respectfully requested. Hiyoshi describes a process for making a paper having a watermark, in which a pattern wire is attached to a paper cloth to form a watermark pattern. Thus, Hiyoshi is not directed to an embossed pattern on the surface of a paper, but to a watermark pattern, i.e., a pattern formed inside the paper by a different arrangement of the fibers within the paper material in the pattern area. As a result, there would have been no motivation to combine the teaching of Britt, which relates to embossed patterns, and the teaching of Hiyoshi, which relates to watermarks. Further, any use of the pattern wire of Hiyoshi instead of the engraved roll of Britt would have resulted in a watermark pattern, not in an embossed pattern.

In contrast, the process of present claims 8 and 16 relates to the formation of an embossed pattern, as recited in claim 8. An advantage of the process of the presently claimed invention is that a damask pattern can be obtained easily and effectively by using a cloth in a metallic or plastic material. This feature of the present invention and its advantages are not taught or suggested in Hiyoshi or Britt, and therefore, present claims 8 and 16 are not obvious over these references taken alone or in any combination.

In view of the above, it is submitted that the rejection should be withdrawn.

Finally, with respect to claims 19-26, it is submitted that none of the cited references

discloses a vat paper machine or any paper machine having the features recited in these claims. Therefore, these claims are patentable over the cited references taken alone or in any combination for similar reasons as discussed above.

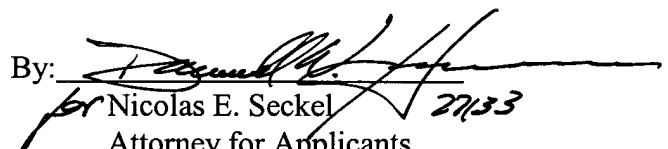
In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 01-2340.

Respectfully submitted,

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